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EXAMINER

YANG, CLARA I

ART UNIT	PAPER NUMBER
2635	

DATE MAILED: 12/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/903,882

Applicant(s)

WACYK, IHOR

Examiner

Clara Yang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9-17 is/are rejected.
- 7) ☒ Claim(s) 5-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 05,06.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "22" has been used to designate both the network control box connecting controller 12 and the network control box connecting controller 12'. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

2. The abstract of the disclosure is objected to because it exceeds the maximum length of 150 words. Correction is required. See MPEP § 608.01(b).

Allowable Subject Matter

3. Claims 5 – 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim Objections

4. Claim 9 is objected to because of the following informalities: Based on the specification (see page 16, lines 4 – 5), a device receives an "Address Request" signal prior to an "Address Inquiry" signal; consequently, the first occurrence of "address inquiry" in claim 9 should be changed to "address request". Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 1 - 8 and 12 - 17 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.

See MPEP § 2172.01.

- ♦ Claims 1 and 12 omit the step of sending a "Stop Transmission" signal by the controller when the controller receives the first address in response to the "Address Request" signal (see specification, page 17, lines 17 - 22). This step is critical for ensuring that the controller only receives one address, thereby making the step of transmitting an "Address Inquiry" signal necessary in order for the controller to identify devices having duplicate addresses.
- ♦ Claim 13 omits the step of a considered or bound device becoming unavailable for subsequent "Address Request" signals. This step is critical in order to prevent the considered or bound device from transmitting its address to subsequent "Address Request" signals. If a considered or bound device is able to respond to subsequent "Address Request" signals, the controller will be unable to receive the addresses of the other devices.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 9 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Patent Application Publication No. U.S. 2002/0175705 A9 (Armstrong et al.).

Referring to Claim 9, Armstrong teaches a radio frequency (RF) transponder 150, as shown in Fig. 11, comprising a state machine 1155 or processor having a common default Tag_ID (see [0062], lines 4 - 7) and a transceiver controlled by tag TX/RX control 1180 for transmitting and receiving signals (see [0054], lines 5 - 11; [0078], lines 1 - 9; and [0079], lines 1 - 3). Armstrong's state machine 1155 is programmed to (a) transmit its Tag_ID or address in response to receipt of a Read Tag_ID command or "Address Request" signal (see [0054], lines 5 - 11); (b) generate a random Tag_ID in response to receipt of a Re-select Tag_ID command or "Randomize Address" signal (see [0062], lines 11 - 14 and 19 - 26); (c) transmit the new random Tag_ID in response to receipt of a subsequent Read Tag_ID (see [0062] and 34 - 42); and (d) transmit the new Tag_ID upon receiving a Read Tag_Data command addressed to its new random Tag_ID (see [0064], lines 10 - 28). Because Armstrong's Read Tag-Data command causes a transponder 150 to transmit its Tag-ID along with data stored in its memory if the received Tag_ID is the same as transponder 150's Tag-ID, it is understood that the Read Tag-Data command also functions as an "Address Inquiry" signal.

Regarding Claim 10, Armstrong's host computer 100 is also able to cause transponder 150 to replace its Tag_ID with a separate and distinct Tag-ID by transmitting a Replace Tag_ID command (see [0063], lines 1 - 5). Per Armstrong, when host computer 100 detects that the Tag-ID of a particular transponder 150 is identical to an existing Tag_ID, host computer 100 transmits a Replace Tag_ID command, which includes the old Tag_ID for addressing the transponder and the new Tag_ID, to the particular transponder 150 (see [0063], lines 21 - 26). Upon receiving the command, transponder 150 stores the new Tag_ID in a temporary register,

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transmits the new Tag-ID back to host computer 100, and replaces its old Tag_ID with the new Tag-ID upon receipt of an acknowledge signal from host computer 100 (see [0063], lines 26 - 42).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1 - 3, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,337,619 (Kowalski et al.) in view of Patent Application Publication No. U.S. 2002/0175705 A9 (Armstrong et al.).

Referring to Claims 1 - 3, 12, and 13, Kowalski's system comprises a terminal T or controller having a processor and a transceiver (see Col. 1, lines 17 - 14 and 27 - 32; and Col. 4, lines 7 - 16). Kowalski's method of selecting or binding an electronic module from a group of modules, wherein each module has its own address, comprises the following steps performed by terminal T: (a) sending a general query message ACTIVALL to the modules (see Col. 4, lines 7 - 16); (b) receiving or considering a first identification message ID3 or address from a module M3 in the group and causing the remaining modules M1 and M2 to set themselves in an idle or deselection state (see Col. 4, lines 24 - 26 and 37 - 53); (c) sending a selection message SELECT-ID3 to module 3 (see Col. 4, lines 30 - 34); (d) receiving a response R from module 3 (see Col. 8, lines 63 - 67); and (e) sending a HALT message to the selected or considered module in order to inhibit the module from responding to subsequent general query messages ACTIVALL (see Col. 8, lines 27 - 38). Kowalski imparts that a module can be in seven states, including a

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selected state SEL, which is understood to indicate that the module is considered by terminal T, and an execution state EXEC, which is understood to indicate that the module is bound since it is to be controlled by terminal T (see Col. 8, lines 18 - 26). Kowalski teaches that steps (a) through (e) are then repeated in order for terminal T to select other modules that have yet to communicate with terminal T (see Col. 8, lines 31 - 36). Though Kowalski's method lacks the step of sending an interrogation signal or address inquiry signal to determine the presence of modules having a specific address, the Examiner takes Official Notice that controllers with the ability to determine whether a specifically addressed transponder is present are well known. Consequently, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kowalski's method such that terminal T or controller transmits an address inquiry signal in order to determine the presence of modules having a specific address in order to identify duplicate addresses prior to transmitting commands, thereby preventing the reception of a command by a plurality of modules having the same addresses. Kowalski's method further lacks the steps of (f) determining whether one or more additional responses to the address inquiry are received from one or more modules in the group and (g) instructing all devices having the same address to generate a random address.

In an analogous art, Armstrong's method includes (a) host computer 100 or controller transmitting a Read Tag_ID command to transponders 150 and determining from the received Tag_IDs if there is a transponder 150 that has the same Tag_ID or address as another transponder 150; and (b) host computer 100 transmitting a Re-select ID command or "Randomize Address" signal to a group of transponders 150 having the same Tag_ID, instructing transponders 150 to generate a random Tag_ID (see [0062], lines 11 - 26); and (c) host computer 100 retransmitting a Read Tag_ID command and receiving Tag_IDs from

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transponders 150. If duplicate Tag_IDs are detected again, Armstrong discloses that steps (b) and (c) until each transponder 150 has a unique Tag_ID (see [0047], lines 1 - 4 and [0062], lines 11 - 26).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kowalski's method as taught by Armstrong because causing modules/device to generate random addresses upon detection of duplicate addresses greatly reduces interference and enables terminal T/controller to control and/or communicate with a particular module.

11. Claims 4 and 14 - 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,337,619 (Kowalski et al.) and Patent Application Publication No. U.S. 2002/0175705 A9 (Armstrong et al.) as applied to claims 1 - 3, 12, and 13 above, and further in view of U.S. Patent No. 6,133,832 (Winder et al.).

Regarding Claims 4 and 14, Kowalski and Armstrong's method lacks the step of instructing the first device (i.e., the selected or considered device) to provide a sensory output that identifies the first device to an operator.

In an analogous art, Winder's method for locating articles includes the steps of: (a) transmitter unit 16 or controller transmitting the access code or address of a tag 12 that is to be located; (b) a plurality of tags 12 receiving transmitter unit 16's signal, decoding the signal, and determining if the received access code is for that particular tag 12; and (c) tag 12 activating tag speaker drive circuit 108 if tag 12 determines that the received access code is its own, causing speaker 78 to emit a user recorded message or a predetermine alarm sound, and laser diode drive circuit 110, causing laser diode 86 and laser diode movement structure drive circuit 112 to generate a moving laser beam or visual output (see Fig. 5).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kowalski and Armstrong's device and method as taught by Winder because the step of generating audio and visual outputs upon being selected/considered by a controller enables a user to confirm aurally and visually which device is communicating with the controller, thus making the system user-friendly.

Regarding Claims 15 and 16, Kowalski's method, as modified by Armstrong method also includes the steps of: (h) binding a module by transmitting a command COM after selecting or considering the module; (i) removing the module from further consideration when the module is in a SEL (considered but unbound) state or EXEC (considered and bound) state; and (j) repeating the method beginning at step (a) in Claim 12 (see Col. 8, lines 31 - 36).

12. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patent Application Publication No. U.S. 2002/0175705 A9 (Armstrong et al.) as applied to claims 9 and 10 above, and further in view of Patent Application Publication No. U.S. 2002/0084890 A1 (Guerrieri et al.).

Armstrong's device is an RFID transponder, not a lamp.

In an analogous art, Guerrieri teaches a system comprising a modular light devices or lamps and an interrogator or controller. Guerrieri's lighting apparatus includes microcontroller 20 (see Fig. 5) and a programmable communication means such as an RFID transponder or tag, thereby enabling an interrogator or reader to send and receive signals to and from transponder in order to identify and control the lighting apparatus. (See [0056].)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Armstrong's device as taught by Guerrieri because there is a need for wireless and programmable lamps that are able to provide varying amounts of light in

accordance with programmed instructions and are adaptable for a plurality of purposes (see Abstract, [0012], and [0018]).

13. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,337,619 (Kowalski et al.) and Patent Application Publication No. U.S. 2002/0175705 A9 (Armstrong et al.) as applied to claims 12 and 13 above, and further in view of Patent Application Publication No. U.S. 2002/0084890 A1 (Guerrieri et al.)

Kowalski and Armstrong's device is an RFID transponder, not a lamp.

In an analogous art, Guerrieri teaches a system comprising a modular light devices or lamps and an interrogator or controller. Guerrieri's lighting apparatus includes microcontroller 20 (see Fig. 5) and a programmable communication means such as an RFID transponder or tag, thereby enabling an interrogator or reader to send and receive signals to and from transponder in order to identify and control the lighting apparatus. (See [0056].)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Armstrong's device as taught by Guerrieri because there is a need for wireless and programmable lamps that are able to provide varying amounts of light in accordance with programmed instructions and are adaptable for a plurality of purposes (see Abstract, [0012], and [0018]).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- ♦ U.S. Patent No. 4,656,463 (Anders et al.): Anders teaches an interrogation method wherein a specific RFID tag address is queried.

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- ◆ U.S. Patent No. 5,838,226 (Houggly et al.): Houggly teaches a system for controlling lights via an RF communication system, wherein local controls 50 or devices are assigned/bound to specific buttons on a master control.
- ◆ U.S. Patent No. 6,174,073 (Regan et al.): Regan teaches an RF remote-controllable lighting system, wherein each lighting unit includes and RF transponder.


☺

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clara Yang whose telephone number is (703) 305-4086. The examiner can normally be reached on 8:30 AM - 7:00 PM, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (703) 305-4704. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

CY
19 November 2003


BRIAN ZIMMERMAN
PRIMARY EXAMINER